

REMARKS

Claims 80-86, 89-98, 101-110, and 113-116 are pending. In an Office Action mailed April 13, 2007, claims 80, 92 and 104 were rejected under 35 U.S.C. §112, claims 80, 81, 92, 93, 104 and 105 were rejected under 35 U.S.C. §102(e) as unpatentable over U.S. Patent App. No. 2001/0011250 ("Paltenghe"), and claims 82-86, 89-91, 94, 96-98, 101-103, 106-110, and 113-115 were rejected under 35 U.S.C. §103(a) as unpatentable over Paltenghe in view of U.S. Patent No. 6,915,271 ("Meyers"). Claim 116 is new. No new matter has been added.

35 U.S.C. §112 Rejections

The Office Action asserts that claims 80, 92 and 104 are indefinite because the current and parent applications do not describe an "offer originating from the data subject accessing a Web page of the data recipient." This is incorrect; such offers are described throughout the specification. For example, an offer originating from a data subject accessing a Web page of a data recipient is described on page 5, lines 5-9:

During the web surfing process, **a data subject browses an authorized data recipient's Web site** via the data subject's NCD. The NCD may be any communications device connected to the network. In this example, it is assumed that the NCD is a computer. The authorized data recipient's Web site invites the data subject to send a set of data subject information to the authorized data recipient **thereby consummating a transaction (an "offer")**.

(Emphasis added). Thus, the specification describes an offer originating from a data subject, where the data subject is accessing a Web page of a data recipient. Further examples of support include page 9, lines 8-19, page 12, lines 11-17, page 14, lines 17-24, and throughout the specification. The language identified by the Office Action is supported by the present application, and it is not indefinite. It is respectfully submitted that the phrase "offer originating from the data subject accessing a Web page of the data recipient" should be given the broadest reasonable meaning consistent with its use in the specification. Withdrawal of the rejection is respectfully requested.

35 U.S.C. §102 Rejections

Independent claim 80 recites, in relevant part, an offer associated with a data recipient and a message including a network communication device software identifier, the offer originating from the data subject accessing a Web page of the data recipient. Independent claims 92 and 104 recite similar features. As explained in the Amendment filed January 22, 2007, Paltenghe does not teach or suggest such a feature. Paltenghe merely describes a virtual wallet in which information can be stored. There is no description of an offer originating from a data subject accessing a data recipient's Web page.

This shortcoming of Paltenghe was described in the Amendment filed January 22, 2007. In response, the Examiner asserts that Paltenghe describes offers as required by the claims at paragraphs 0007 and 0068. This is incorrect. Paragraph 0007 merely describes the use of cookies to track a user's visits to a website. The ordinarily skilled artisan would never infer that a "cookie," which is something that a user does not generate or originate, would be an "offer," which would be something that clearly would originate from a user. There is simply no suggestion that a cookie, which records a user's visit to a website regardless of whether a purchase is made, can somehow be an offer as required by the claims.

Paragraph 0068 similarly fails to describe an offer originating from a data subject accessing a data recipient's Web page. In fact, paragraph 0068 teaches away from such an offer by describing an anonymous shopping service:

[0068] The information bank also provide an anonymous shopping service. This service, as shown in FIG. 11, allows several components of the information bank (such as the service account 33, an anonymizer module 153 which assigns an alias to all consumer transactions, an order payment consolidator module 155, a junk e-mail investigator module 157 and a reshipper module 159 to work together to provide an intermediate shopping service which allows the consumer to browse certain merchant displays over the Internet without revealing their identity. The modules and functions described are conventional and well known, for example, from such services already available from certain web service providers. However, to date, no one has integrated the noted functions and modules into a coherent functioning system as provided by the present invention.

(Emphasis added.) In Paltenghe, the information bank provides an intermediate layer which prevents direct interaction between the data subject (the consumer, as interpreted by the Examiner) and the data recipient (the merchant, as interpreted by the Examiner). This paragraph only describes browsing merchant websites via an intermediate service. It does not describe the origination of an offer from the entity doing the browsing. Moreover, it would completely defeat Paltenghe's anonymous shopping service for an offer to originate from a data subject as required by the claims, since the merchant would then be able to identify the consumer, and the consumer would no longer be anonymous. *See, e.g., In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). Thus, Paltenghe fails to teach or suggest an offer as recited in the claims.

Further, it is noted the Office Action cites the "merchant offers" of paragraph 0062 as anticipating the "offer associated with the data recipient" required by the claims. However, these offers are sent by merchants to the information bank, which then forwards them to a consumer if they match the consumer's profile. *See* ¶ 0062. Thus, it is impossible for these "merchant offers" to originate from a consumer as suggested by the Office Action. Regardless of whether a data subject browses a web page of a data recipient in Paltenghe, there is no teaching of an offer originating from a data subject, and Paltenghe cannot anticipate the claims.

35 U.S.C. §103 Rejections

Meyer fails to remedy the shortcomings of Paltenghe described above, and claims 82-86, 89-91, 94, 96-98, 101-103, 106-110, and 113-115 are allowable for at least the reasons given above for the independent claims. Withdrawal of all rejections and reconsideration is respectfully requested.

Conclusion


Based on the above remarks, Applicants believe the claims are in condition for allowance. The Commissioner is authorized to charge any fees or credit any overpayment to the deposit account of Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

Appl. No. 09/559778
Reply to Office Action of Apr. 13, 2007

The Examiner is invited to contact the undersigned to discuss any matter concerning this application.

Respectfully submitted,

Date: July 13, 2007



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